

*Privy Council Appeal No. 115 of 1930.*

E. P. Mohamed Noordin     -     -     -     -     -     -     -     *Appellant*

*v.*

S. E. S. Abdul Kareem and Company and another -     -     -     *Respondents*

FROM

THE COURT OF APPEAL OF THE STRAITS SETTLEMENTS  
(SETTLEMENT OF PENANG).

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JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF THE  
PRIVY COUNCIL, DELIVERED THE 6TH JULY, 1931.

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*Present at the Hearing :*

LORD THANKERTON.  
LORD RUSSELL OF KILLOWEN.  
SIR LANCELOT SANDERSON.

[*Delivered by* LORD RUSSELL OF KILLOWEN.]

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This is an appeal, in a passing-off action, from a judgment of the Court of Appeal of the Straits Settlements (Settlement of Penang). The trial Judge dismissed the claim of the plaintiffs to an injunction. The Court of Appeal reversed that judgment and granted an injunction against the two defendants. From this decision the first defendant (who will be referred to as the appellant) appeals to His Majesty in Council, joining as respondents to the appeal the plaintiff and the other defendant.

The matter comes before their Lordships in an unsatisfactory shape, and although the crucial question which ultimately emerges is capable of brief statement, it is unfortunately necessary to set out at length the facts of the case for the purpose of making clear the course of decision and the points involved.

The goods which are alleged to be passed off are "sarongs," or loin cloths, which are purchased and worn by Malays. These goods, which are woven in India, are imported into Penang and sold there. The various importers distinguish their goods by means of labels which are affixed to the sarong, and which consist

of or contain some particular "chop" (*i.e.*, brand or mark), which identifies the sarong as being the goods of a particular importer, or as being the goods of a particular brand.

There is no statutory law of trade marks in the Straits Settlements, nor any registration thereof; but it would appear to be the custom there for traders to describe their marks as registered trade marks and to advertise them, with illustrations and explanations, in the Government Gazette. For the purposes, however, of the present case it would appear to their Lordships that the respective marks of the parties only come into play as elements (and in the circumstances of the case the principal elements) for consideration in determining whether the appellant should be subjected to a passing-off injunction at the suit of the plaintiffs: for it should be stated at the outset that no passing-off or attempted passing-off is alleged against the appellant except by the use by him on his sarongs of one particular label.

The facts leading up to the present litigation may now be stated.

The plaintiffs started business in Madras about the year 1916. They exported sarongs to a firm in Penang under a label known in this case as B<sup>1</sup>. It was a red oblong label upon which was printed in gold, as the central feature, a fez or tarboosh with its tassel. Above this hat or cap there appeared, printed in gold, "No. 1," and below it, "Regd. Trade Mark." These three printings were enclosed in a golden framework or device, which contained the following inscriptions:—(1) At the top, in English, "S. E. S. Abdul Kareem and Bros., Madras." (2) At the bottom, in Malay, "Kareem's Cloth." (3) At the sides, in Malay, "Chop Kopiah Tarboos" (*i.e.*, Mark Hat Tarboosh), and "Kain Pulicat Number Satoo" (*i.e.*, Cloth, Pulicat No. 1). Pulicat was the place where the cloth was woven. The Penang firm to whom the plaintiffs originally exported were a firm called "A. M. N. Ahamadsa, Mahomed Noordin and Company." In 1924 this firm broke up, and it would seem as if the Penang business was taken over by the Madras firm, and that thereupon the Madras firm, who exported the sarongs to Penang, and the Penang firm who sold them there, became identical. The new Penang firm changed their name in 1926 to coincide with their Madras firm name, and there is no doubt (as the trial Judge stated) that the red label with the fez (B<sup>1</sup>) was well-established and popular in Malaya.

In 1926 one S. Mohamed Hussain Sahib (who may be conveniently referred to as the second defendant) was carrying on business in Penang as a retail dealer in sarongs, selling as a principal line sarongs which were exported to Penang by the appellant from Madras, with a dog-cart brand upon them. In December of that year the second defendant determined to import sarongs wholesale under a mark of his own. For this purpose he adopted a mark showing a glass or tumbler called "Chop Glass." He had blocks prepared, and of these he sent

one to the appellant in Madras and one to another trader in Madras, E. M. V. Ramalingam Chettiar. This he did in order that these two traders, who were to buy sarongs for him from the weavers, might print the labels from the blocks and affix the labels to the sarongs which they consigned to the second defendant.

This particular label is a red and gold label (known in this case as C<sup>1</sup>), and it would appear to be a close imitation in all respects of B<sup>1</sup>. The central feature of the glass or tumbler printed in gold upon a red ground (with the words "Chop Glass. Regd. Trade Mark," beneath it), resembles nothing so much as an inverted fez or tarboosh. Its use was promptly challenged by the plaintiffs, who in May, 1927, commenced an action against the second defendant, which was compromised upon the terms contained in an agreement dated the 28th September, 1927. By this agreement the second defendant undertook not to use any shade of red to print his glass mark, or to sell any sarongs bearing the glass mark printed on any shade of red, after four months from the date thereof; but he was to print his glass mark on blue paper. The plaintiff withdrew his claim in the pending suit and undertook "not to print his trade mark, Chop Tarboos, upon blue paper or papers of any of the shades and hue of the blue colour."

Thereupon the second defendant substituted for C<sup>1</sup> a label which was an exact reproduction of C<sup>1</sup>, printed, however, upon blue paper.

In November, 1927, the plaintiffs changed their mark B<sup>1</sup> to a form identified in these proceedings as B<sup>2</sup>. This label is B<sup>1</sup> in different colours. It is printed on white paper, with the following colouring:—The framework containing the inscriptions was coloured red; the fez or tarboosh was coloured red, with a blue tassel; the ground of the inside of the framework, upon which the tarboosh was shown with "No. 1" (above) and "Regd. Trade Mark" (below), was coloured yellow. The margin of white which was shown on the label was small, the general appearance presented was of a red and yellow label, with a red tarboosh as the central feature.

Soon afterwards the second defendant adopted as his label a label which is identified in these proceedings as C<sup>2</sup>. This label is C<sup>1</sup> in different colours. The framework is blue and gold; the ground inside the framework is yellow, and upon it appears the glass or tumbler in gold and blue, with "No. 1" and "Chop Glass. Regd. Trade Mark" in gold.

In the year 1929 the plaintiffs began to put sarongs on the market under an entirely new label.

This new label of the plaintiffs (identified in these proceedings as B<sup>3</sup>) was a white label upon which was printed in red a framework, in the top portion of which appeared the words "S. E. S. Abdul Kareem & Bros., Madras," and down the sides and in the bottom portion of which appeared inscriptions in Malay characters,



one of which meant "Chop Topi Achai." In the centre of the framework, the ground of which was white, was printed in red ink (at the top) "No. 1," (at the bottom) "Regd. Trade Mark," and in between the figure of a hat or cap, also printed in red ink. This hat or cap has upon it a very variegated pattern; it has no tassel, and is obviously a hat or cap quite different from the fez or tarboosh which appeared on the former labels of the plaintiffs. It is an Achinese hat, which is usually woven of fibre with check patterns on it.

About the same time the appellant began to use on sarongs a label (identified in these proceedings as C<sup>3</sup>) which also contained as its central feature an Achinese hat. This label requires description in some detail. It is printed on white paper; the framework is created by a thin inner yellow rectangular line contained within a thin outer yellow rectangular line, the groundwork in between the yellow lines being white. On the top left-hand corner of this white groundwork appears a green trefoil with a black letter E thereon; on the top right-hand corner appears a red trefoil with a black letter P thereon; on the bottom left-hand corner appears a yellow trefoil with a green letter M thereon; and on the bottom right-hand corner appears a dark blue trefoil with a yellow letter N thereon. The letters E, P, M, N obviously stand for the appellant, E. P. Mohamed Noordin. In between the green and red trefoils appear the words "E. P. Mohammed Noordin. Madras—Penang." Along the other sides of the framework appear certain inscriptions in Malay characters. In the centre of the framework, which enclosed a white ground, there was printed in red ink (at the top) "No. 1," in dark blue ink (at the bottom) "Registered Trade Mark," and, in between, the coloured figure of an Achinese hat, with an elaborate pattern picked out in red, green, yellow, black and white.

In the Penang Gazette of the 13th February, 1929, there appeared an advertisement or notice by the plaintiffs in relation to their mark. The notice contained a representation in black and white of B<sup>2</sup> and ran thus:—

"This Red Fez Cap with the dark Tassel is our Trade Mark registered in India, Malaya and the Dutch East India. And nobody shall counterfeit this or use other colourable imitations under other names in any manner calculated to mislead distant or near sight. Anyone found using such false marks or any agent of any firm in India, Malaya or elsewhere found using such labels on sarongs manufactured in India and marketing them in Penang, Singapore, F.M.S., Sumatra and other places will be dealt with according to law and shall be liable to us for losses and other damages."

In the Gazette of the 8th March, 1929, a further advertisement or notice by the plaintiffs appeared. It contained representations in black and white of B<sup>2</sup> and B<sup>3</sup>, and ran thus:—

"Notice is hereby given that the Fez Cap above depicted and called 'Kopia Tarbuz,' 'Turki Topi,' 'Kopia Achai,' 'Achai Topi' and appearing in labels of white, black, red, blue, green, yellow or any other colour or mixture of colours are the Registered Trade Marks of S. E. S. Abdul Kareem & Co., carrying on cloth business at Penang and Madras, exclusively used

by them in respect of their 'sarongs' (Kain Pulicat) and other similar cloth manufactured, imported and sold by them in the Straits Settlements, Federated Malay States, Unfederated Malay States, Dutch East Indies, Borneo, Siam, French Indo-China and elsewhere.

"It is hereby warned that any person or persons whomsoever using the said Trade Marks or any colourable imitation thereof, either using the name or designs or shapes thereof or otherwise infringing the rights of the said S. E. S. Abdul Kareem & Co. in the respect of any sarongs kain or other similar cloth in the said countries, shall be liable to all damages and loss which the said S. E. S. Abdul Kareem & Co. may suffer by reason of said infringement."

In the same issue of the Gazette appeared an advertisement or notice by the appellant in relation to C<sup>3</sup>.

In the Penang Gazette of the 11th March, 1929, a further notice or advertisement by the plaintiffs appeared, similar in terms to the one of the 8th March, but with the addition after the words "Achai Topi" of the words "or any other kind or shape of cap."

At this point it may be stated that (according to the trial Judge) "Topi" is an Indian word which means hat or cap, and has become in Malaya a familiar word bearing that meaning. The Malay word for a cap is "Kopiah." The two words are in use, but while the latter tends to mean a kind of cap commonly worn by Malays, the former rather indicates foreign headgear.

On the 18th March, 1929, the plaintiffs issued their writ against the appellant and the second defendant, by which they claimed in general terms "an injunction to restrain the defendants, their servants and agents from infringing the plaintiffs' Topi trade marks and from selling or offering for sale goods bearing such infringing marks."

The writ does not disclose the exact causes of action against the respective defendants. To ascertain these reference must be made to the statement of claim, and for this purpose the document must be examined with some care.

The statement of claim makes the following allegations against the defendants:—1st. It alleges that both defendants sold sarongs with the label C<sup>2</sup> and that this label is a colourable imitation of the plaintiffs' labels B<sup>1</sup> and B<sup>2</sup>. 2nd. It alleges that by using the label C<sup>2</sup> the second defendant committed a breach of the agreement of the 28th September, 1927. 3rd. It alleges that the appellant deliberately imitated the plaintiffs' label B<sup>3</sup> by means of his label C<sup>3</sup>, and that both defendants have sold sarongs bearing the label C<sup>3</sup>, which is described as "the said imitation Chop Topi Achai Mark." There is also a reference in para. 13A to some other Chop Glass label, but this may be disregarded.

The allegations in the statement of claim conclude thus:—

"17. By reason of the wrongful acts aforesaid the defendants have sold and passed off or caused to be sold and passed off large quantities of

goods not of the plaintiffs' manufacture as and for the plaintiffs' goods and have gained large profits thereby, and the plaintiffs have thereby suffered loss and damage."

It is clear to their Lordships that the statement of claim contains no allegation that the label C<sup>3</sup> in any way resembles or infringes B<sup>1</sup> or B<sup>2</sup>, or that goods sold with the label C<sup>3</sup> are or will be confused with goods sold under the labels B<sup>1</sup> or B<sup>2</sup>. The allegations are that C<sup>2</sup> is a colourable imitation of B<sup>1</sup> and B<sup>2</sup>, and that C<sup>3</sup> is a deliberate imitation of B<sup>3</sup>. This is one of the unsatisfactory features of the case, for as will presently appear the relief which was ultimately granted against the appellant rests solely upon the view that C<sup>3</sup> is an imitation and infringement of B<sup>1</sup> and B<sup>2</sup>; that is to say, that if the appellant sells sarongs with his label C<sup>3</sup> affixed thereto they will be taken for the sarongs which the plaintiffs have sold and sell under the labels B<sup>1</sup> and B<sup>2</sup>.

The appellant did not seek before this Board to escape from this adverse judgment upon the technical ground that the statement of claim contained no allegation to justify it, because admittedly the issue, though not raised on the pleadings, was to some extent discussed both in the evidence and in the arguments at the trial. The manner in which the plaintiffs' case was presented in the statement of claim is, however, as will appear, of importance from another point of view.

The conclusions reached by the trial Judge may now be stated. As regards the label C<sup>2</sup>, he held that the appellant was not responsible for its use. As regards its use by the second defendant, he held that the second defendant could not be made liable upon the footing of breach of contract or otherwise. As regards the labels B<sup>3</sup> and C<sup>3</sup>, he held that their appearance in Penang was simultaneous, so that the plaintiffs could not obtain any relief founded upon the user by them of B<sup>3</sup>. He then stated that the issue was not whether C<sup>3</sup> was an infringement of B<sup>3</sup>, but whether C<sup>3</sup> was an infringement of B<sup>1</sup> or B<sup>2</sup>. His words may properly be quoted:—

"My task, as stated, is confined to a comparison, not between the two contemporary *topi achai* marks, but between plaintiffs' *chop topi tarboosh* with its labels B<sup>1</sup> and B<sup>2</sup>, and first defendant's *topi achai*, with its label, Exhibit C<sup>3</sup>. I think it is impossible to look at these two marks or labels and believe that one could be mistaken for the other. Plaintiffs' *fez* brand is either B<sup>1</sup> in dull red with lettering and designs upon it in gold, or it is B<sup>2</sup> in red frame with yellow central background (vitiating, as stated, by a blue tassel). It is quite impossible to mistake these two labels for first defendant's *topi achai* label, C<sup>3</sup>. The latter has a white background throughout. The framing is in black lines with yellow filling. The lettering is all in black, round the frame and in the centre. The two pictures of the *fez* and the *topi achai* bear no sort of resemblance to each other at all. The sole possibility of confusion between the two brands lies in the name alone."

The view of the trial Judge is that the label C<sup>3</sup> is entirely distinct from and is incapable of being mistaken for or confused with the labels B<sup>1</sup> or B<sup>2</sup>. With this view the Court of Appeal

agreed, and it commends itself to their Lordships. No one could mistake the one for the other, or imagine that the Achinese headgear which appears in C<sup>3</sup> was the same headgear as the fez or tarboosh which appears in B<sup>1</sup> or B<sup>2</sup>. It must, however, be borne in mind that the only ground alleged or suggested for the possibility of confusion or passing-off is the use of this label C<sup>3</sup>.

In these circumstances it appears to their Lordships essential for the success of the plaintiffs that they should establish by evidence that their goods are known by some name or description of such a nature that the use of the label C<sup>3</sup> will cause people to think that goods bearing that label are the goods of the plaintiffs.

The plaintiffs, realising this, sought to prove that their goods were known and asked for as "Chop Topi" goods, which may be translated as Hat-Brand goods or Cap-Brand goods; so that sarongs offered for sale under any label which contained, or contained as its distinctive feature a hat or cap, would be confused with and taken for sarongs of the plaintiffs.

The point upon which, in their Lordships' view, the determination of this appeal depends can now be stated, viz., did the plaintiffs by their evidence establish that their goods are known as "Chop Topi goods," so that a person would be deceived by C<sup>3</sup> into thinking that sarongs bearing that label were sarongs of the plaintiffs? In other words, did the plaintiffs prove that their sarongs are known as Chop Topi goods generally, apart from the representation of the particular form of Topi, viz., a fez or tarboosh?

The answer to this crucial question must necessarily depend upon the evidence available in the case. The trial Judge has, upon the evidence, come to a conclusion adverse to the plaintiffs. His finding is thus expressed:—

"The sole possibility of confusion between the two brands lies in the name alone. And I cannot hold that plaintiffs have established an exclusive right to the name chop topi generally, divorced from the picture of fez or tarboosh. I think, indeed, that their adoption of a topi achai mark shows that they themselves have realised that.

"I must hold that the majority of customers would rely upon, not only the name of the chop, but also upon its pictorial representation; possibly also upon the name of the importer and, in a lesser degree, upon the colouring and get-up of the label. In not one of these detailed and possibly distinctive features is there any room at all for any confusion between plaintiffs chops B<sup>1</sup> and B<sup>2</sup> on the one side, and first defendant's chop C<sup>3</sup> on the other."

Their Lordships read those words as meaning that the plaintiffs failed to establish that their sarongs are known as "Chop Topi" without reference to the fez or tarboosh. They understand the trial Judge to mean that the plaintiffs' sarongs are generally known as "Chop Fez" or "Chop Tarboosh," and that even in the cases where they are known as "Chop Topi" the customer means or has in mind the particular form of hat or cap known as fez or tarboosh.



Their Lordships do not propose to analyse the oral evidence appearing in the record, but there are two features in relation thereto which should be mentioned. The first is that the oral evidence appears to be mainly directed to the consideration of Chop Topi as compared with Chop Glass, and not of B<sup>1</sup> and B<sup>2</sup> as compared with C<sup>3</sup>. In other words, the oral evidence followed mainly the line of the pleadings. There is very little oral evidence upon the question whether goods sold under C<sup>3</sup> would be confused with the plaintiffs' goods. The second feature is that the only record of the oral evidence is a copy of the Judge's note. This note shows the combined result of question and answer, but it contains no indication as to how far the words recorded represent the phraseology of the witness or the phraseology of counsel.

In these circumstances their Lordships would be even more disinclined than is usual to review the findings of fact of a Judge who has heard and observed the witnesses; even if (which is not the case here) they thought that the oral evidence might have justified a different view. But in the present case there exist considerations, apart from the oral evidence, which support and emphasise the opinion of the trial Judge. One such consideration is that at the time of the compromise with the second defendant the plaintiffs could not have considered themselves entitled to the exclusive use of a cap or hat in connection with their sarongs; for they conceded to the second defendant the enjoyment of a mark which was apparently an inverted fez, subject only to the condition that he abandoned the colour red; in other words, they compromised on the basis of colour, and not on the basis of the abandonment of a mark which might be taken for a hat or cap. In fact, in the compromise agreement the plaintiffs call their mark "Chop Tarboos," and not "Chop Topi." Another consideration is that the plaintiffs' advertisement or notice in the Gazette of the 13th February, 1929 (only one month before action) makes no exclusive claim to a cap or hat brand. On the contrary, the claim is limited to "This Red Fez Cap with the dark Tassel." In the Gazette of the 8th March, 1929, they claim sundry descriptions in connection with their marks B<sup>2</sup> and B<sup>3</sup>, such as "Kopia Tarbuz," "Turki Topi," "Kopia Achai," and "Achai Topi," but not "Chop Topi" or Topi alone. The same is true of the Gazette of the 11th March, 1929, but in that issue for the first time they lay claim not only to the Fez Cap, but also to "any other kind or shape of cap," and in any colour. This would appear to be a belated endeavour to lay a foundation for an exclusive right to all kinds of hats or caps as marks on sarongs; but when the statement of claim is delivered in the action no such claim is made.

These considerations appear to their Lordships to support and corroborate the view adopted by the trial Judge as the result of the oral evidence.

The trial Judge by his judgment of the 23rd September, 1929, dismissed the claim for an injunction against both defendants,



and ordered the plaintiffs to pay two-thirds of each defendant's costs of action.

The plaintiffs appealed, and the Court of Appeal allowed the appeal and reversed the judgment of the 23rd September, 1929, against both defendants.

The appeal was heard on the 16th and 17th February, 1930, and on the latter day the result of the appeal and the findings of the Court of Appeal were announced. The relevant findings were :—

(1) That the second defendant committed a breach of the agreement of the 28th September, 1927, in using C<sup>2</sup> ;

(2) That in regard to B<sup>3</sup> and C<sup>3</sup> there had not been a sufficient length of usage to justify either party taking proceedings against the other ;

(3) That in regard to C<sup>3</sup> *vis-a-vis* B<sup>2</sup>, so far as the labels themselves are concerned, the plaintiff had no case ; but

(4) " That he has a case against anyone who puts, as we think the defendant No. 1 [*i.e.*, the appellant] put, on the market an article which is likely to acquire the name of the plaintiff's article, namely, Chop Topi."

There is no record of the oral judgments which were delivered at the time, but it would seem clear from the formal findings above referred to that the Judges in the Court of Appeal were in agreement with the trial Judge upon the points that the plaintiffs had no cause of action at all based upon their user of B<sup>3</sup>, and that by no possibility could C<sup>3</sup> be confused with B<sup>2</sup>. It is further clear that they granted relief against the second defendant as regards his use of C<sup>2</sup> upon the footing that such user was a breach of contract. Finally, it would seem that they granted relief (and, as will appear, against both defendants) as regards the use of C<sup>3</sup> upon the footing that, the plaintiffs' goods being known as Chop Topi, goods sold under a mark containing or consisting of a cap would be likely to acquire the name Chop Topi and be confused with the goods of the plaintiffs.

The formal order of the Court of Appeal in its operative and relevant part runs thus :—

" This Court doth order that this appeal be allowed and that the said judgment dated the 23rd day of September, 1929, be reversed as against both defendants (respondents). And the Court doth order that the defendants or either of them, their servants and agents be restrained by the injunction of this Court from infringing the plaintiffs' trade marks in the pleadings mentioned and from affixing or applying or causing to be affixed or applied to any sarong not manufactured by the plaintiffs any mark or label containing the representation of a fez or topi or any colourable imitation of the plaintiffs' said marks or any marks or device which would be calculated to cause any sarongs on which they were fixed to be believed to be of the manufacture of the plaintiffs, always save and except the blue label used by the second defendant and referred to in clause 11 of the statement of claim and marked C.I.A. in terms of an agreement made between the plaintiff and the second defendant dated the 28th day of September, 1927."

Then follows certain relief against the second defendant alone.

There has been no appeal against this order by the second defendant. Upon the appellant appealing to His Majesty in Council, the three learned Judges of the Court of Appeal furnished (in the months of August, September and October, 1930, respectively) their written reasons for the judgments which they had pronounced in the previous February. The reasons are stated in detail by Thorne J., and his judgment is adopted and accepted by the other members of the Court.

It will have been obvious from the findings recorded in February that the foundation of the relief granted against the appellant is the crucial finding that the name of the plaintiffs' article is Chop Topi, carrying with it the consequence that the plaintiffs have acquired the exclusive right to use a cap as a mark on their goods.

It would seem, therefore, at first sight that the Court of Appeal took a different view from the trial Judge as to the result of the evidence and had reversed him upon a question of fact. But a perusal of the judgment of Thorne J. reveals that the decision of the Court of Appeal is based upon a misconception of what the trial Judge's finding had been. Thus his finding is stated in one part of the judgment to have been that the plaintiffs had "established a trade name of 'Chop Topi' upon the Penang market." It was no such thing. It was the exact reverse, viz., that the plaintiffs had failed to establish a trade name of Chop Topi divorced from the picture of fez or tarboosh. Later in the judgment the finding of the trial Judge is more accurately quoted, but it is apparently misinterpreted. It is regarded as a finding adverse to the defendants, from which they might have appealed, and as a finding which entitles the plaintiffs to prevent other traders from affixing to their sarongs a label containing any representation of a cap or hat.

It thus appears that the decision of the Court of Appeal is based upon a misconception in relation to the crucial fact in the case. This fact the trial Judge has found in the appellant's favour. Their Lordships see no reason to doubt, but much ground for approving, the correctness of that finding. Unless the plaintiffs proved that crucial fact, they could have no case for restraining the appellant from using a label which everyone agrees is incapable of confusion with B<sup>1</sup> or B<sup>2</sup>. The only method of passing-off which is suggested against the appellant is the use by him of the label C<sup>3</sup>. Before the plaintiffs can assert a right to prevent that user, they must establish as a condition precedent that they have an exclusive right to use a cap or hat as a mark for sarongs, and this they have failed to do.

The decision in this case involves no new principles of law. It depends entirely upon its own facts. It is therefore unnecessary to refer to or consider the authorities which were cited by Mr. Morton in the course of his full and careful argument. Indeed, the

question might well be asked, which was propounded by Lord Watson in *Johnston v. Orr Ewing* (7 App. Cas. 219), a case much relied upon by the plaintiffs: "How can observations of Judges upon other and quite different facts bear upon the present case, in which the only question is, what is the result of the evidence?" In that case the evidence established that the name of the plaintiff's goods was "two elephants" goods, and the defendants were accordingly restrained from using on competing goods a label with two elephants. In that case the crucial fact was proved. Here it was not.

Further, it is unnecessary to consider how far the trial Judge was justified in his strictures upon the conduct of the appellant. All that their Lordships need say is that the appellant's conduct in relation to C<sup>1</sup> seems to have been confined to affixing it at the request of the second defendant to goods which he, as agent, was consigning from India to the second defendant. He was not using C<sup>1</sup> as his own mark. Nor is it clear to their Lordships how his misconduct, if any, in relation to C<sup>1</sup> is relevant in relation to the subsequent introduction by him of the label C<sup>2</sup>. The plaintiffs' case, however, breaks down at an earlier stage, and before the conduct of the appellant becomes a relevant matter for consideration.

For the reasons above given their Lordships are of opinion that this appeal should succeed.

The order of the Court of Appeal will require to be recast in view of the fact that in so far as it affects the second defendant, who has not appealed, it must stand. It must, however, be varied so as to give the appellant the full relief to which he would have been entitled as a successful respondent upon that appeal.

It must be varied in so far as it reverses the judgment of the trial Judge as against the appellant, and in so far as it grants an injunction against him or orders him to pay any costs.

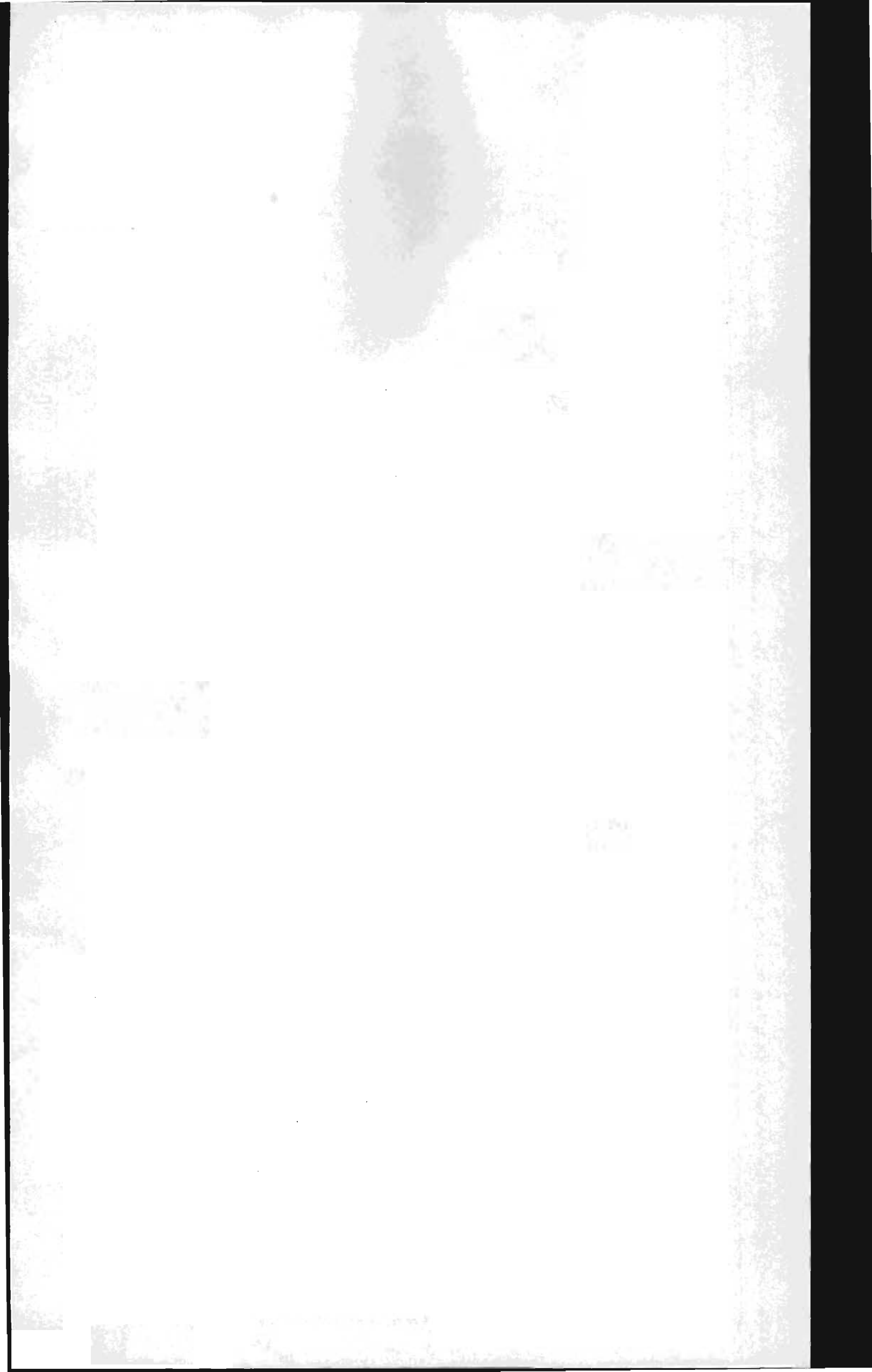
As so varied and with no other variation the operative part of the order should run thus:—

"This Court doth order that as against the first defendant, E. P. Mohamed Noordin, this appeal be dismissed, but that as against the second defendant, S. Mohamed Hussain Sahib, this appeal be allowed and the said judgment dated the 23rd day of September, 1929, be reversed. And this Court doth order that the second defendant, his servants and agents, be restrained by the injunction of this Court from infringing the plaintiffs' trade marks in the pleadings mentioned and from affixing or applying or causing to be affixed or applied to any sarong not manufactured by the plaintiffs any mark or label containing the representation of a fez or topi or any colourable imitation of the plaintiffs' said marks or any marks or device which would be calculated to cause any sarongs on which they were fixed to be believed to be of the manufacture of the plaintiffs always save and except the blue label used by the second defendant and referred to in clause 11 of the statement of claim and marked C.I.A. in terms of an agreement



made between the plaintiff and the second defendant dated the 28th day of September, 1927. And this Court doth order and adjudge that under the said agreement the second defendant was prohibited from using any colour except blue or any shade or hue of blue on the second defendant's Chop Glass label. And the Court doth further order as against the second defendant that he and his servants be restrained by the injunction of this Court from committing a breach of the undertaking of the second defendant contained in the said agreement referred to in paragraphs 11 and 12 of the statement of claim. And it is adjudged that the plaintiffs recover against the second defendant the sum of \$1,000, being liquidated damages as provided in the said agreement. And this Court doth make no order on paragraphs 2 and 3 of the prayer in the statement of claim. And it is ordered that the costs of the plaintiffs of this action be taxed as between party and party and that the second defendant do pay to the plaintiffs one-half of the costs up to the close of the pleadings and one-third of the costs subsequent thereto, and it is ordered that the appellants do pay to the first defendant his costs of this appeal and that the second defendant do pay to the appellants their costs of this appeal, to be taxed in each case as between party and party, and this Court doth certify for two Counsel for the plaintiffs both in this Court and the Court below and doth certify for two Counsel for the first defendant in this Court."

The appeal should be allowed and an order should be made in the terms above set out in substitution for the order made by the Court of Appeal and dated the 18th February, 1930, and their Lordships will humbly advise His Majesty accordingly. The respondents S. E. S. Abdul Kareem & Co. will pay the appellant's costs of this appeal.



In the Privy Council.

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E. P. MOHAMED NOORDIN

v.

S. E. S. ABDUL KAREEM AND COMPANY  
AND ANOTHER.

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DELIVERED BY LORD RUSSELL OF KILLOWEN.

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